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09/729,484	12/04/2000	Connie T. Marshall	ODS/018	5978

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EXAMINER

NGUYEN, BINH AN DUC

ART UNIT	PAPER NUMBER
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3714

MAIL DATE	DELIVERY MODE
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04/03/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/729,484

Applicant(s)

MARSHALL ET AL.

Examiner

Binh-An D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-8, 14-18 and 21-30 is/are pending in the application.
- 4a) Of the above claim(s) 5-7 and 15-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4, 8, 14, 18 and 21-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

The Request for Continued Examination filed February 5, 2009 has been approved. Further, the Amendment filed February 5, 2009 has been received. According to the Amendment, claims 1-3, 9-13, 19, and 20 have been canceled; claims 4 and 14 have been amended; and new claims 21-30 have been added.

Currently, claims 4-8, 14-18, and 21-30 are pending in this application, wherein claims 5-7 and 15-17 have been previously withdrawn due to non-elected inventions. Claims 4, 8, 14, 18, and 21-30 are hereby examined on the merits. Acknowledgment has been made.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 26-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 26, the preamble renders the claim vague and indefinite since it is unclear whether the control circuitry claimed is an additional circuitry. It appears that the claimed limitations in the body of the claim are performed by the circuitry claimed in claim 14. If so, claim 26 should be amended such as "The system of claim 14, wherein the control circuitry further receives..."

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 4, 8, and 21-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As clarified in *Bilski*, (see *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008)), the test for a method claim is whether the claimed method is (1) tied to a particular machine or apparatus, or (2) transforms a particular article to a different state or thing. This is called the “machine-or-transformation test”. There are two corollaries to the machine-or-transformation test. First, a mere filed-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. This means the machine or transformation must impose meaningful limits on the method claim’s scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle to a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such a data gathering or outputting, is not sufficient to pass the test.

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, *for example* by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that it is being transformed, *for*

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example by identifying the material that is being changed to a different state. (emphasis added)

In keeping with the requirement that a claim should positively recite the particular machine or apparatus to which it is tied, the following operations procedure is set forth:

“Identifying the apparatus” requires that the process claim explicitly recite the particular machine or apparatus, or recite a step that inherently involves the use of a particular machine or apparatus.

The definition of an “inherent tie” is as follows:

The step requires a particular machine or apparatus such that the step cannot be performed mentally or manually in a manner the reasonable accomplishes the intended purpose of the recited invention, a claimed, without the use of a structure.

In this case, claims 4, 8, and 21-25 lack the identification of an a machine or apparatus that performs the claimed method. Accordingly, the claim is non-statutory under 35 U.S.C. 101.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 4, 8, 14, 18, 24, 25, 29, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Brenner et al. (5,830,068).

Referring to claim 14, Brenner et al. teaches a system of providing a user interface for interactive wagering, comprising:

a user input device (122)(Figure 1) that accepts user inputs (2:32-67; 8:15-28; 9:5-25; 9:67-10:7); and

control circuitry (140)(Figure 2)(7:55-67) that receives an indication from a first user of a first wagering preference as one of the user inputs, *e.g., player starts the interactive racing game by selecting race tracks, races, wager types, and wager amounts*, that stores the first wagering preference during a first wagering session, that identifies the first user in at least one first subsequent wagering session; that, in response to identifying the first user, uses the stored first wagering preference as a default selection in subsequent wagers in the at least one first subsequent wagering session, *e.g., the setting that could be reused as in “duplicate a wager” option (12:45-50)*, wherein the subsequent wagers are associated with at least a track selection, a race selection, a bet type selection, a bet amount selection, and a horse selection (Figs. 8-11; 18:41-67, and that provides the first user with an opportunity to change the default selection for at least one of the subsequent wagers from the default selection to another selection *e.g., selecting “duplicate a wager,” “more bets same race,” or “delete” wager, (12:27-50) (Figs.8-19).*

Note that, the “duplicate a wager” function provides the user with an opportunity to place a new wager from previously wager selections, which in fact is a saved player

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preference or player default setting. Further note that, Brenner et al.'s teaching of user selection of "more bets same race" (12:27-37) wherein the same race being reused is considered as a default or saved player preference.

Regarding applicant's amended limitations of storing the first wagering preference during a first wagering session, and using the stored wagering preference as a default selection in subsequent wagers in the at least one first subsequent wagering session, these are still inherent from Brenner et al.'s teaching of "duplicate a wager" function that provides the user with an opportunity to reuse the wager amount from previous wager selections, the previous selected wager amount has been stored and never been altered when it being referred back at a subsequent wagering session. Also, Brenner et al.'s teaching of user selection of "more bets same race" (12:27-37) wherein the same race being reused, and is considered as a default or saved player preference.

Referring to claim 4, the system of Brenner et al. above is capable of performing a method of providing a user interface for interactive wagering, comprising:

receiving an indication from a first user of a first wagering preference, *e.g.*,
accepting user inputs (2:32-67; 8:15-28; 9:5-25; 9:67-10:7);

storing the first wagering preference during a first wagering session, *e.g.*, *the user inputs being stored for subsequent wagers such that some of the user's inputs or player preference could be reused* (12:27-50);

identifying the first user in at least one first subsequent wagering session;

in response to identifying the first user, using the stored first wagering preference as a default selection in subsequent wagers in the at least one first subsequent wagering session, wherein the subsequent wagers are associated with at least a track selection, a race selection, a bet type selection, a bet amount selection, and a horse selection (Figs. 8-11; 18:41-67);

and providing the user with an opportunity to change the default selection for at least one of the subsequent wagers from the default selection to another selection e.g., selecting “duplicate a wager,” “more bets same race,” or “delete” wager, (12:27-50) (Figs.8-19).

Note that, the “duplicate a wager” function provides the user with an opportunity to place a new wager from previously wager selections, which in fact is a saved player preference or player default setting. Further note that, Brenner et al.’s teaching of user selection of “more bets same race” (12:27-37) wherein the same race being reused is considered as a default or saved player preference.

Regarding applicant’s amended limitations of storing the first wagering preference during a first wagering session, and using the stored wagering preference as a default selection in subsequent wagers in the at least one first subsequent wagering session, these are still inherent from Brenner et al.’s teaching of “duplicate a wager” function that provides the user with an opportunity to reuse the wager amount from previous wager selections, the previous selected wager amount has been stored and never been altered when it being referred back at a subsequent wagering session. Also,

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Brenner et al.'s teaching of user selection of "more bets same race" (12:27-37) wherein the same race being reused, and is considered as a default or saved player preference.

Referring to claims 8 and 18, Brenner et al. teaches the at least one default setting of the default wager is a previously selected track (using the hot button to bet on the next race and by pass selection steps 196, 204, and 213)(Figure 3 and column 17, lines 10-26, or using the "duplicate a wager" feature).

Referring to claims 24 and 29, Brenner et al. teaches the control circuitry identifies the first user by authenticating the first user using a PIN (e.g., personal identification code, 4:43-56; 15:53-55).

Referring to claims 25 and 30 wherein the control circuitry (or method step thereto) identifies the first user by identifying the first user from a plurality of authorized users of the user interface, this limitation is inherent from Brenner et al.'s teaching of users must establish accounts in orders to play (7:35-54).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-23 and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brenner et al. (5,830,068).

Brenner et al. teaches all limitations of claims 4, 8, 14, 18, 24, 25, 29, and 30 as being addressed above.

Referring to claims 21-23 and 26-28, Brenner et al. does not explicitly disclose a second user, wherein control circuitry (or steps thereto) that receives an indication from a second user of a second wagering preference; stores the second wagering preference during a second wagering session; identifies the second user in at least one second subsequent wagering session; and in response to identifying the second user, uses the stored second wagering preference as a default selection in subsequent wagers in the at least one second subsequent wagering session; the first wagering preference and the second wagering preference are different wagering preferences (claims 22 and 27); the first user and the second user are different users (claims 23 and 28); however, since the user terminal (122) of Brenner et al. is capable of allowing different users to play (e.g., each registered user must log in using personal identification code in order to play, 4:43-56; 15:53-55) it would have been obvious to a person of ordinary skill in the art at the time the invention was made to recognize that the user terminal of Brenner et al. could be used by different people in the same residence of the machine such as family members and or roommates who play the game differently.

Response to Arguments

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Applicant's arguments with respect to claims 4, 8, 14, 18, and 21-30 have been considered but are moot in view of the new ground(s) of rejection necessitated by the Amendment.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh-An D. Nguyen whose telephone number is 571-272-4440. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on 571-272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dmitry Suhol/
Supervisory Patent Examiner, Art
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